

Remarks

Applicants appreciate the careful examination given to the Application as reflected in the Office Action mailed May 24, 2007. Reconsideration and favorable action in this Application is respectfully requested.

Claims 1-3 remain pending and rejected in this Application.

Claims 42-45 and 47 have been canceled.

§102(b) Rejection of Claims

The Office Action rejects claim 42 under 35 U.S.C. §102(b) as being anticipated by *Hoogstoel, et al.* (U.S. Patent No. 2,744,624).

Claim 42 has been canceled. The rejection of claim 42 is moot.

§103(a) Rejection of Claims 1, 2 and 3

The Office Action rejects claims 1 – 3 under 35 U.S.C. §103(a) as being unpatentable over *Straub* (U.S. Patent No. 4,824,702) in view of *Ferraro* (U.S. Patent No. 4,511,608), *Kriozere* (U.S. Patent No. 4,348,440) and *Ittershagen, et al.* (U.S. Patent No. 5,168,831).

With respect to the rejection of claims 1-3 under 35 U.S.C. §103(a), Applicants respectfully suggest that these claims are patentable and not obvious in view of the above references.

According to §2142 of the MPEP [R-6], to establish a *prima facie* case of obviousness, there must be a clear articulation of the reasons why the claimed invention would have been obvious under the Supreme Court's decision in *KSR Int'l V. Teleflex, Inc.*, 127 S.Ct. 1727, 82 U.S.P.Q. 2d 1385 (2007). Furthermore, rejections on obviousness cannot be sustained with mere conclusory statements, but rather must be supported by articulated reasoning with a rational

underpinning to support the legal conclusion of obviousness. *In re Kahn*, 441 F3rd 977, 78 U.S.P.Q. 1329 (Fed. Cir. 2006).

At §2142 of the MPEP [R-6] goes on to instruct that:

To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical ‘person of ordinary skill in the art’ when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention ‘as a whole’ would have been obvious at that time to that person. Knowledge of applicant's disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the "differences," conduct the search and evaluate the ‘subject matter as a whole’ of the invention. The tendency to resort to ‘hindsight’ based upon applicant’s disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

The MPEP at § 2143 [R-6] goes on to set out the basic requirements of a *prima facie* case of obviousness. Under the Supreme Court’s *KSR* decision, seven rationales are provided to support a conclusion of obviousness which are consistent to the obviousness determination in *Graham v. John Deere Co.*, 383 U.S. 1 (1966). These rationales include:

- A. Combining prior art elements according to known methods to yield predictable results;
- B. Simple substitution of one known element for another to obtain predictable results;
- C. Use of known technique to improve similar devices (methods, or products) in the same way;
- D. Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
- E. “Obvious to try” – choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;
- F. Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one

based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art; and,

G. Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

In our case, the Office Action fails to establish a *prima facie* case of obviousness for several reasons. First, the Office Action fails to state *explicitly* how the prior art makes the invention of Applicant obvious. Second, the combination of references cited in the Office Action appears to be assembled through the impermissible use of hindsight, using Applicant's invention as a template. Third, the combination of references raised by the Office Action is unworkable and defeats the purpose of most, if not all of the individual references.

I. The Office Action Fails to Set Forth Explicitly the Reasoning for the *Prima Facie* Case of Obviousness

At pp. 3-6, the Office Action appears to argue that four references are combined to provide the elements of Applicant's claim 1. However, *how* the references are combined is unclear. For example, the Office Action does not set out how the *Kriozere* reference or the *Ittershagen* reference is *actually* combined with the other references (if any) to arrive at the claimed invention. Specifically, at p. 5, ln. 4, the language "double sided adhesive elements of *the references*" is ambiguous and can refer to either the *Ferraro* reference or the *Straub* reference or both. At ln. 13 of p. 5, the language "double side adhesive element of *the references*" referring to the *Ittershagen* reference is unclear as to how the *Ittershagen* reference is combined with the other references. The language in the Office Action does not make clear whether the *Ittershagen* reference is combined with the *Kriozere* reference, the *Ferraro* reference or the *Straub* reference or any combination of those references. It is respectfully submitted that the ambiguity presented by the Office Action does not comport with the Supreme Court's

guidance in *KSR*, the requirements of the MPEP or an explicit delineation of the reasoning that Applicant's invention is obvious in view of the references cited be made.

Arguments Related to the Combination of References.

In combining the four references, the Office Action appears to adopt the rationale letter "G" of the MPEP by arguing that some teaching, suggest or motivation in the prior art would lead one of ordinary skill to modify some combination of the prior art references or combine them to arrive at the claimed invention. However, the application of this rationale is flawed in several respects.

Under the teaching, suggestion, motivation rationale, it is necessary to ascertain whether the prior art teachings would appear to be sufficient to one of ordinary skill in the art to suggest making the claimed substitution or other modification. *In re Lalau*, 747 F.2d 703, 223 U.S.P.Q. 1257, 1258 (Fed. Cir. 1984). Furthermore, it is not enough for the Office Action to present references that contain the assorted features of the invention. The Office Action must also state explicitly why it would appear that the references would have been combined. *See, In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q. 2d 1780, 1783 (Fed. Cir. 1992) (The examiner can satisfy this burden only by showing some objective teaching in the prior art or that some knowledge generally available to one of ordinary skill in the art would lead the individual to combine the relevant teachings of the references).

When the Office Action proposes a combination that makes a prior art reference inoperable for its intended purpose, that prior art reference may be considered to teach away from the proposed combination, that is, not to teach the combination, thereby supporting a showing of non-obviousness. *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) (Finding no suggestion to modify a prior art reference with a modification which

would render the device inoperable for its intended purpose). The Federal Circuit has provided guidance on this point as follows:

We have noted elsewhere, as a ‘useful general rule’, that references that teach away cannot serve to create a *prima facie* case of obviousness....if references taken in combination will produce a ‘seemingly inoperable device’, we have held that such references teach away from the combination and thus cannot serve as predicates for *prima facie* case of obviousness.” *McGinley v. Franklin Sports, Inc.* 262 F.3d 1339, 60 U.S.P.Q.2D 1001, 1010 (Fed. Cir. 2001).

Furthermore, a suggestion to combine the references must not require substantial reconstruction or redesign of the references to arrive at the claimed invention. *In re Rattai*, 270 F.2d 810, 123 U.S.P.Q. 349 (CCPA 1959). *Also see, In re Spinnoble*, 405 Fed. 2d 578, 587, 160 U.S.P.Q. 237, 244 (CCPA 1969) (References taken in combination teach away because they would produce a seemingly inoperable device).

A further indication of a potentially defective obviousness rejection is the inclusion of separate references to represent each of the different features that are described in the claims of the application. In this situation, many times the claimed invention has been used as an “instruction manual” to piece together prior art that might render the claims obvious. In this process the examiner has lost sight of the real issue that is, whether it would have been obvious to combine the references without having access to the application that is under examination to arrive at the claimed invention. *See, e.g., Ex Parte Crawford, et al.*, Appeal No. 20062 429, *decided* May 30, 2007; *see also, Lear Siegler, Inc. v. Aeroquip Corp.*, 733 F.2d 881, 221 U.S.P.Q. 1025, 1033 (5th Cir. 1984). It is impermissible for the Office Action to use the application itself as the basis or reason for formulating the obviousness rejection. As worded by the Federal Circuit:

It is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art

so that the claimed invention is rendered obvious. This Court has previously stated that “one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention” *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2D 1780, 1784 (Fed. Cir. 1992).

Finally, the Supreme Court has indicated that “common sense” should be observed in the determination of obviousness. *KSR* 127 S. Ct. at 1727, 82 U.S.P.Q. 2s at 1397. The BPAI has further instructed that obviousness must be judged from the perspective of an artisan exercising common sense to combine the teachings of numerous references. *See, Ex Parte Green*, Appeal 2007 1271, *decided* June 12, 2007; *also see, Ex Parte Rinkevich, et al.*, Appeal 2007 1317, *decided* May 29, 2007.

II. A Person of Ordinary Skill in the Art Employing Common Sense Simply Would Not Have Made the Combinations Suggested by the Office Action.

The Office Action advances the argument that it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the “equivalent length” and “bisected release layers” of *Ferraro* in the “article” of *Straub* because they are shown to be “functionally equivalent alternate expedients”.

Straub discloses a method and apparatus for producing sheets of adhesive labels wherein a die cut top liner material extends beyond the areas of the adhesive to form a lip around the perimeter of the adhesive areas. *See, Straub* col. 2, lines 52 – 54. The essential feature of the *Straub* device is that the top liner material *includes a lip extending beyond the areas of the adhesive* so that in the manufacturing process, the die cut does not come in contact with the adhesive material. *See, Straub* col. 2, lines 55 – 58. Figure 4 of the *Straub* reference is shown below and is representative of the invention disclosed:

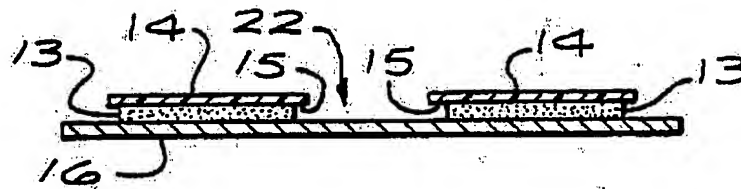


Figure 4

Ferraro discloses a method and apparatus for mounting and reinforcing artificial fingernails using a commercially available double faced tape. *See, Ferraro* col. 2, lines 20 – 57. The essential features of the *Ferraro* device are that the tabs of double-sided, pressure sensitive adhesive material are dimensioned for providing a quick and easy way for mounting an artificial fingernail to a natural nail. *See, Ferraro* col. 1, lines 49 – 56. Figure 6 of the reference, shown below, is helpful in visualizing the invention disclosed:

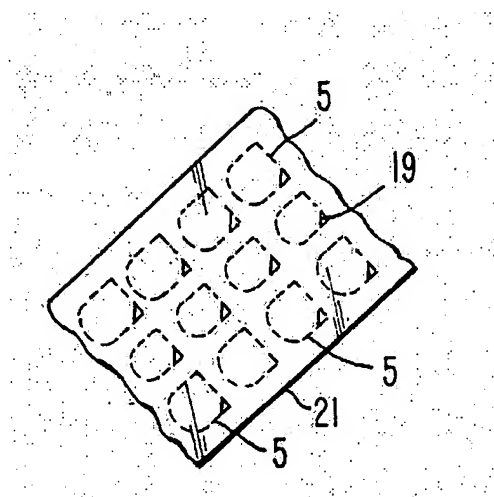


Figure 6

The invention of *Straub* cannot be combined with the invention of *Ferraro* because the two references combined do not teach all the elements of the claimed invention, there is no suggestion or motivation for the combination and because the references teach away from the combination.

Ferraro does not disclose a bisecting cut, **19** as advanced by The Office Action at page 4, lines 13 -14 (“*Ferraro* shows that release layers substantially the same length as each of the strips and including a bisecting cut, **19**...”). Rather, *Ferraro* discloses that the feature at reference number **19** is a set of *embossed lines* provided on each side of the protective layers **9** and **13** of the tabs **5** to facilitate removal of the protective layers **9** and **13** (emphasis added). See, *Ferraro* col. 3, lines 3 – 6. “Embossed” is defined as – “Embellished with a raised pattern created by pressure or embroidery” or “Ornamented with a raised design.” See, Dictionary.com, <http://dictionary.reference.com/browse/embossed>, attached as Exhibit 1. “Bisected” is defined as – “To cut or divide into two parts, especially two equal parts.” See, Dictionary.com, <http://dictionary.reference.com/browse/bisected>, attached as Exhibit 2. Embossed lines **19** are located in the corner of each tab **5** as shown in Figures 5 and 6 of the reference. It is clear from the description and the location of reference **19** on each tab that the raised pattern **19** on each tab **5** neither cuts each tab nor “bisects” each tab into two equal parts, but in fact provides a raised protrusion designed to facilitate the removal of the protective layers **9** and **13**. Since there is no “bisecting cut” as advanced by the Office Action (and as required by the claim), the combined references do not provide all the required limitations set out in claims 1 – 3 and therefore fail to adequately support a *prima facie* case of obviousness.

A. The Combination of *Straub* and *Ferraro* is Unworkable

There is insufficient suggestion or motivation to combine the “release layers” of *Ferraro* in the article of *Straub*. The adhesive sheet material of *Straub* includes lip **15** extending past the adhesive areas **12**. See, *Straub* col. 2, lines 52 – 54 and Figures 1 and 4. Lip **15** provides a means to separate tab **14** from adhesive **12**, the purpose being to allow the edges to be easily grasped by the user. But, the embossed lines **19** of *Ferraro* are included for exactly the same

purpose, that is to facilitate the removal of the protective layers 9 and 13. *See, Ferraro* col. 3, lines 3 – 6. In fact, the Office Action advances the notion that the adhesive devices of *Ferraro* and *Straub* are “functionally equivalent alternate expedients.” *See, Office Action* page 4, lines 17 – 18. One of ordinary skill in the art would not combine two inventions with different features that accomplish the same goal because it is not common sense. Rather, the inventor would choose one or the other to meet his need, not both. Similarly, there is no suggestion or motivation to combine the bisected release layers of *Ferraro* with the article of *Straub* because no advantageous function would be gained. *See, Ex Parte Rinkevich, et al.*, BPAI 20071317, “In the instant case, we conclude that a person of ordinary skill in the art having common sense at the time of the invention would not have reasonably looked to [one reference] to solve a problem already solved by [another].”

B. The Addition of *Kriozere* is Also Unworkable.

The Office Action advances the argument that it would have been obvious to one of ordinary skill in the art at the time the invention was made to make a central slit in the release sheets of the rectangular, double-sided adhesive elements “of the references as combined above” because *Kriozere* shows that a slit along the central longitudinal axis allows for alignment of a rectangular article.

A general relationship in the fields of prior art references to be combined is insufficient suggestion or motivation. *Interactive Techs., Inc. v. Pitway Corp.*, Civ. App. No. 98-1464, Slip Op. at 13, (Fed. Cir. G1 1999) (Unpublished), *cert denied* 528 U.S. 1046 (1999). The motivation or suggestion must be more closely targeted to the invention than a mere general relationship between the prior art and the invention of applicant. *See, In re Alhamad*, Civ. App. 97-1345

(Fed. Cir. Dec. 18, 1997) (Unpublished) (Holding that a general relationship between strength reinforcing was not sufficient suggestion of a fire resistance goal of the invention).

An invention made from a combination of old elements is not obvious if the old elements typically deal with different problems. *Lindermann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 Fed. 2d 1452, 221 U.S.P.Q. 41 (Fed. Cir. 1984) (Holding that an invention combining a single process to process light and heavy gauge metal scrap objects nonobvious for combining two different known features in a single device when the known features solved different problems).

The *Kriozere* reference provides a face stock with a fold line and an adhesive surface to create a pressure sensitive seal used in sealing the open end of sterilized pouches. The essential feature of the *Kriozere* reference is the “adhesive to adhesive” contact around the open end of a sterilized pouch ensures that no contamination will reach the pouch interior. *See, Kriozere* at col. 1, lns. 53-61. The *Kriozere* reference discloses only a single sided tape which is folded over onto itself after being positioned on an open sterilized pouch. Once sealed, there is no exposed adhesive side remaining, only an adhesive free closure to the medical pouch. Figure 4 from the reference provides a representative example:

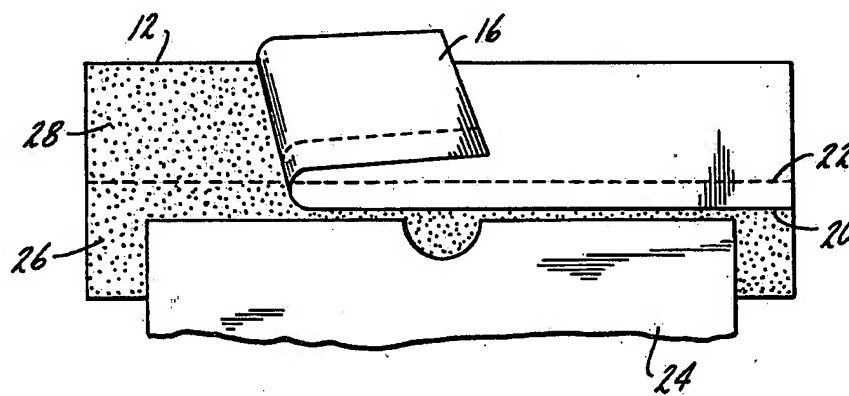


Figure 4

The central slit in the release sheet of the *Kriozere* invention cannot be combined with the invention of *Straub* because there is simply no suggestion or motivation to combine them and further the references teach away from the combination.

The *Straub* invention provides that each tab **14** is *larger* than its respective transfer adhesive area **12** to form lip **15** over the entire perimeter. *See, Straub*, col. 2, lines 53 – 55. An advantage of lip **15** is the ease of release of the tab from bottom liner **16**. However, the split release sheet of the *Kriozere*, shown as **16** and **18**, provides the same advantage, namely, ease of deployment. There is no motivation to duplicate the oversized tab feature of *Straub* by adding the additional slit feature of *Kriozere* because both features, while different, solve the same problem. To duplicate a feature for the same advantage is not common sense. The combination of *Straub* with *Kriozere* also defeats the main advantage of *Straub*. For example, the *Straub* invention provides the advantage of reducing the precision required in the die cuts necessary to make the device. *See, Straub*, Col. 2, lns 2-20. But, adding the additional slit in the release sheet as taught by *Kriozere* would increase manufacturing cost by requiring more precise and exacting die cuts, which is exactly opposite of the intention of the *Straub* invention. The teachings of *Straub* lead clearly away from the combination with *Kriozere*.

The suggestion or motivation stated in the Office Action that *Kriozere* shows the slit along the central longitudinal axis allows for “alignment” of a rectangular article, does not offer any advantage whatsoever in the context of the *Straub* disclosure. The “positioning” referred to by the *Kriozere* reference is the positioning of the fold line **22** with respect to the open end of the pouch to be sealed **24**. The pouch **24** is positioned on the lower side of adhesive **26**. Then the release sheet **16** is pulled, facilitating the adhesive side **28** being folded down onto the adhesive side **26**, forming an adhesive seal around the end of the open bag. *See, Kriozere*, Figures 1 – 4.

However, in the context of the *Straub* invention, the positioning of the tab would not be facilitated at all by a two-piece release layer. In the three uses of the tabs produced by the manufacturing process that is the invention of *Straub*, alignment of the tab is not critical. The first use described in the *Straub* reference is to adhere a false fingernail to a finger. *See, Straub*, col. 3, lines 8 – 10 and Figure 3. The alignment of the false fingernail is guided by the shape and outline of the user's natural nail and finger, not the alignment of an axis. An added slit on the release sheet would provide no particular advantage in aligning the false fingernail onto the natural nail. The second use described in the *Straub* reference is to create decorative stickers on a sheet. *See, Straub*, col. 4, lines 8 – 10 and Figure 7. In this application of the invention, the release layer is never removed because the release layer has the decoration printed on it. A split through the decoration would detract from the decorative effects of the sticker and would be unnecessary since the release layer is not to be removed. The third use described is that of a lint remover. *See, Straub*, col. 4, lines 23 – 26. A lint remover, either on a sheet or on a roll has no use for an aligning strip. The process of removing lint is an inexact science as the adhesive material is repeatedly affixed to and removed from the article until all lint is removed.

C. The Combination of *Kriozere* and *Ferraro* is Also Unworkable.

The central slit in the release sheet of the *Kriozere* invention cannot be combined with the invention of *Ferraro* because there is no suggestion or motivation to combine them and further the references themselves teach away from the combination.

The *Ferraro* disclosure provides a double-sided, pressure sensitive adhesive material from which tabs **5** are fabricated. Each tab **5** includes a suitable carrier **15** coated on each side by adhesive **11** with protective coatings **9** and **13** covering the adhesive **11** on each side of the tab. *See, Ferraro*, col. 2, lines 48 – 54 and Figure 4. *Ferraro* also provides raised (“embossed”)

lines 19 on each side of tab 5 to facilitate removal of the protective layers 9 and 13. *See, Ferraro*, col. 3, lines 3 – 6 and Figures 5 and 6. There is no suggestion or motivation to combine the split release sheet of *Kriozere* with the *Ferraro* reference because the *Ferraro* invention already provides for raised lines on each side of the protective layers to facilitate easy removal of the release layers. It is not common sense to duplicate the ease of release feature of *Ferraro* by adding the ease of release feature of *Kriozere*. Further, adding the additional slit in the release sheet would add a step in the use of the adhesive tab of *Ferraro*, adding complication of use to the invention. Complication of use is contrary to the purpose of *Ferraro*, which touts quick and easy means for mounting an artificial fingernail to a natural nail as one of its main advantages.

The suggestion or motivation argued by the Office Action, namely, that *Kriozere* shows the slit along the central longitudinal axis which allows for “alignment” of a rectangular article, does not offer any advantage in the context of the *Ferraro* disclosure. In the context of the *Ferraro* device, the positioning of the tab would not be facilitated at all by a two-piece release layer.

To use the adhesive tab of *Ferraro*, one protective layer is removed exposing the first adhesive surface and the first adhesive surface is affixed to a natural nail. The remaining protective layer is removed exposing the second adhesive surface to which an artificial nail is positioned and affixed. *See, Ferraro*, col. 2, lines 29 – 38. The artificial nail is aligned into proper position on the natural nail by aligning the perimeter of the artificial nail with the perimeter of the natural nail. The application of the first adhesive surface to the natural nail would not be assisted by a central slit in the protective layer because all that is needed to properly position the first adhesive surface is to see the nail itself. As long as the entire first adhesive surface is in contact with the natural nail, the orientation of the first adhesive surface

has no bearing as to how secure the adhesion to the artificial nail is. Once the artificial nail is placed over the natural nail, the adhesive tab is hidden by design and therefore cannot aid in the aligning of the artificial nail. Furthermore, the fact that the release layer will have already been removed prevents any slit in the release layer from helping position the artificial nail on the natural nail. Altering the structure of the release sheet would not change or help how the positioning of the artificial nail on the natural nail was done, so there is no advantage offered by nor motivation to make the combination of the references.

For these reasons, there would be no motivation or suggestion to one of ordinary skill in the art at the time the invention was made to combine *Kriozere* to *Ferraro*.

D. The Addition of *Ittershagen* Does Not Cure the Deficiencies of the Combination.

The Office Action advances the argument that it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the double-sided adhesive element “of the references as combined above” transparent and with a tack strength to releasably adhere to an animal because *Ittershagen* teaches the benefits of these adhesive materials in preventing an animal from touching undesired regions. The Applicants respectfully submit that the previous references cannot be properly combined with *Ittershagen* because there is no suggestion or motivation to do so and further the references themselves teach away from the combination.

The *Ittershagen* reference discloses a single wide sheet of transparent flexible material covered on one side with an adhesive substance and on the other side with a protective backing. *See Ittershagen*, col. 3, lines 1-12 and lines 38 – 41. *Ittershagen* also discloses that the top layer consists of a stronger adhesive than the bottom layer and further provides two separate adhesive products for the top and bottom adhesive layers. *See, Ittershagen*, col. 3, lines 20 – 39. The

Ittershagen device is manufactured on a roll for ease of storage and transportation. See, *Ittershagen*, col. 3, lines 42 – 45 and Figure 2. The weaker adhesive is placed down (toward the floor) and the stronger adhesive is left exposed on top. See, *Ittershagen*, col. 3, lines 21 – 22. A representative figure is provided by the reference in Figure 2 shown below:

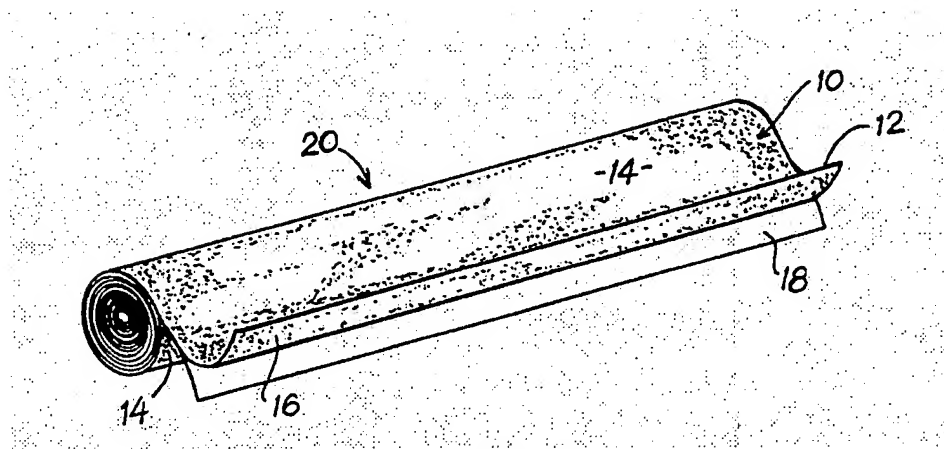


Figure 7

An invention is not obvious where one prior art reference teaches away from combination with a second or other prior art references. *In re Rudko*, Civ. App. No. 98-1505 (Fed. Cir. May 14, 1999)(Unpublished).

Proper motivation to combine references requires that the combination be desirable, not merely possible. *Winner International Royalty Corp. v. Wang*, 202 F.3d 1340, 53 U.S.P.Q. 2d 1580 (Fed. Cir. 2000), *cert denied*, 530 U.S. 1238 (2000) (One of ordinary skill in the art would not have reasonably elected to trade one feature of security versus another of convenience and therefore, the invention was not obvious).

E. The Combination of *Straub* and *Ittershagen*.

There is insufficient suggestion or motivation to combine the transparency and the releasable tack strength of *Ittershagen* with the invention of *Straub* and further the references teach away from the combination.

The *Straub* reference describes its uses as adhering a false fingernail to a finger, creating decorative stickers, and using the invention as a lint remover. *See, Straub*, col. 3, lines 8 – 10, col. 4, lines 8 – 10, and col. 4, lines 23 – 26. The examples of uses disclosed in the specification would be less effective as a fingernail adhesive, a decorative sticker, or a lint remover, if the adhesive were of a releasable tack strength as required by *Ittershagen*. If the tack strength were reduced to where the adhesive tabs of the *Straub* reference were “releasable”, the tabs would no longer function according to their designed purpose. As a result, *Straub* teaches away from a tack strength of releasable adhesion as disclosed in *Ittershagen* and therefore the combination of the two references is improper.

There is also insufficient suggestion or motivation to combine the invention of *Ittershagen* with the invention of *Straub* because there would be little if any use to the transparency of *Ittershagen* in the context of *Straub*. There would be no motivation to make the *Straub* tabs transparent because they would be covered by a false fingernail in use. Also, another use suggested in *Straub* involves the adhesive for the tabs being dispensed in a pattern, where the pattern constitutes a message or a design to be viewed. *See, Straub*, col. 4, lines 27 – 34. One of ordinary skill in the art at the time the invention was made would have no motivation to make the *Straub* tabs transparent as required by *Ittershagen* because invisible tabs could not be used to make a message.

F. The Combination of *Ittershagen* and *Ferraro*.

The transparency and the releasable tack strength of the adhesive of *Ittershagen* cannot be combined with the invention of *Ferraro* because there is simply no suggestion or motivation to combine them and further the references teach away from the combination.

The *Ferraro* reference discloses the use of its double-sided adhesive tabs to be a quick and easy means for mounting an artificial fingernail to a natural fingernail. *See, Ferraro*, col. 1, lines 49 – 52. The adhesive strength of the *Ferraro* tab 5 must provide both for retention of the artificial nail 1 upon the fingernail 3 during normal daily activities of the user. *See, Ferraro*, col. 2, lines 41 – 47. If the tabs of *Ferraro* had an adhesive with a releasable tack strength as required by *Ittershagen*, the tabs would not be able to retain the artificial nail upon the fingernail during normal daily activities and therefore cease to function as designed.

There is also insufficient suggestion or motivation to combine the *Ittershagen* reference with *Ferraro* because there would be little if any use to the transparency of *Ittershagen* in *Ferraro*. The adhesive tabs are dimensioned for covering a substantial portion of the area of the fingernail. *See, Ferraro*, col. 2, lines 24 – 26 and Figure 1. The tabs are designed to accommodate different size and shape fingernails. *See, Ferraro*, col. 2, lines 26 – 29 and Figure 5. During use, the false fingernail will cover the entire adhesive tab. There would be no motivation to make the *Ferraro* tabs transparent because in use they are always covered by a false fingernail and the adhesive tab is never apparent.

For these reasons there is no motivation or suggestion to one of ordinary skill in the art at the time the invention was made to make the double-sided adhesive elements of *Ferraro* combined with the transparency and releasable tack strength of the adhesive of *Ittershagen*.

G. The Combination of *Ittershagen* With *Kriozere*.

The invention of *Ittershagen* cannot be combined with the invention of *Kriozere* because there is no suggestion or motivation to combine them and further the references teach away from the combination.

The *Kriozere* reference provides a pressure sensitive seal member used in sealing the open end of sterilized pouches. An absolutely essential feature of the *Kriozere* reference is the adhesive-to-adhesive contact around the open end of the pouch insuring that no contamination will reach the pouch interior (*Kriozere* at col. 1, lines 53 – 61). Releasable adhesion such as suggested by *Ittershagen* would weaken the seal, thereby increasing the possibility of contamination and rendering the invention useless. Furthermore, the *Ittershagen* invention has adhesive on two sides. If applied in the context of *Kriozere*, the outside of the pouch seal would be sticky. This is a non-functional combination which is simply not common sense. Therefore, the combination of the two references is improper because the very use, structure and purpose of *Ittershagen* would lead one of ordinary skill in the art away from the invention of *Kriozere*.

H. Claims 2 and 3.

With respect to claims 2 and 3, the Office Action states that *Straub* shows the strips are uniformly spaced apart from one another by gaps on the transfer sheet that are parallel to the length of the strips and are of a width that is equal to a substantial fraction of the width of the strips to provide an indication of an edge of the plurality of the strips. As pointed out above, there is no motivation or suggestion to one of ordinary skill in the art to combine the *Straub* reference with any of the *Ferraro*, *Kriozere*, or *Ittershagen* references. Further, the rejections under § 103 as to claims 2 and 3 also lack sufficient explicit explanation to support the rejections. Further, the four references combined by the Office Action, *Straub*, *Ferraro*, *Kriozere* and *Ittershagen* do not provide all the required limitations set out in claims 1 – 3 and therefore together they fail to adequately support a *prima facie* case of obviousness. Finally, claims 2 and 3 depend from claim 1 and therefore are patentable because the elements of claim 1 are patentable.

§ 0103 Rejections of Claims 43, 44, 45 and 47

The Office Action rejects claims 43 – 44 under 35 U.S.C. §103(a) as being unpatentable over *Hoogstoel, et al.* (U.S. Patent No. 2,744,624).

Claims 43 – 44 have been canceled. The rejection of claims 43 – 44 is moot.

Claims 45 and 47.

The Office Action rejects claims 45 and 47 under 35 U.S.C. §103(a) as being unpatentable over *Hoogstoel, et al.* (U.S. Patent No. 2,744,624) in view of *Bode* (U.S. Patent No. 2,096,389) and *Kriozere* (U.S. Patent No. 4,348,440).

Claims 45 and 47 have been canceled. The rejection of claims 45 and 47 is moot.

§112 First Paragraph Rejection of Claims

The Office Action rejects Claims 45 and 47 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement.

Claims 45 and 47 have been canceled. The rejection of claims 45 and 47 is moot.

§112 Second Paragraph Rejection of Claims

The Office Action rejects claims 1 – 3 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Office Action states the claim language of claim 1 contains contradictory claim limitations, specifically “unperforated” and “completely bisected.” Applicant respectfully traverses that conclusion. As described at *Dictionary.com*, “unperforated” is defined as – “lacking perforations.” *See*, Exhibit 3. Additionally, “perforations” is defined as – “A hole, or one of a series of holes, bored or punched through something, as those between individual

postage stamps of a sheet to facilitate separation.” Combining both definitions, “unperforated” means lacking a hole or a series of holes, bored or punched through to facilitate separation. Further, according to *Dictionary.com*, “bisected” is defined as – “To cut or divide into two parts, especially two equal parts.” *See*, Exhibit 2.

The release layers as described in claim 1 are not perforated as they do not include a hole or series of holes to facilitate separation. The release layers as described in claim 1 are completely bisected into two equal halves and are adapted to be removed from the second adhesive surface. The terms “unperforated” and “completely bisected” are not contradictory terms and the release layers of claim 1 can be simultaneously described by both limitations “unperforated” and “completely bisected.”

Therefore, it is submitted that claim 1 (and pending claims 2 and 3) are definite and comply with the requirements of 35 U.S.C. §112, second paragraph.

Applicants Have Submitted Evidence of Secondary Considerations of Non-Obviousness

Section 2142 of the MPEP [R-6] points out that:

With regard to rejections under 35 U.S.C. 103, the examiner must provide evidence which as a whole shows that the legal determination sought to be proved (i.e., the reference teachings establish a *prima facie* case of obviousness) is more probably than not.

When an applicant submits evidence, whether in the specification as originally filed or in reply to a rejection, the examiner must reconsider the patentability of the claimed invention. The decision on patentability must be made based upon consideration of all the evidence, including the evidence submitted by the examiner and the evidence submitted by the applicant. A decision to make or maintain a rejection in the face of all the evidence must show that it was based on the totality of the evidence. Facts established by rebuttal evidence must be evaluated along with the facts on which the conclusion of obviousness was reached, not against the

conclusion itself. In re Eli Lilly & Co., 902 F.2d 943, 14 U.S.P.Q. 2d 1741 (Fed. Cir. 1990).

The presentation of evidence of secondary considerations is often the key to overcoming an obviousness rejection. For example, the Federal Circuit has held that:

Evidence of secondary considerations may often be the most probative and cogent evidence in the record. It may often establish that an invention appearing to have been obvious in light of the prior art was not. It is to be considered as part of all the evidence, not just when the decision maker remains in doubt after reviewing all the art. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538-40, 218 U.S.P.Q. 871, 879 (Fed. Cir. 1983).

In a crowded field, such as that presented by the prior art in this case, small differences may make all the difference as to non-obviousness. For example, the Federal Circuit recognized this principle as follows:

Thus when differences that may appear technologically minor nonetheless have a practical impact, particularly in a crowded field, the decision-maker must consider the obviousness of the new structure in this light. Such objective indicia as commercial success, or filling an existing need, illuminate the technological and commercial environment of the inventor, and aid in understanding the state of the art at the time the invention was made. *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 20 U.S.P.Q. 2d 1746, 1752 (Fed. Cir. 1991).

When evidence of secondary consideration exists, it is always to be considered, not merely when the Examiner remains in doubt after reviewing all the prior art. *Cable Elec. Prods., Inc. v. Genmark, Inc.*, 770 F.2d 1015, 226 U.S.P.Q. 887 (Fed. Cir. 1985).

An Applicant need not show that all possible embodiments within the claims are successfully commercialized in order to rely on the success of the marketplace of the embodiment that was commercialized. *Applied Materials, Inc. v. Advance Semiconducting Materials Amc.*, 98 F.3d 1563, 40 U.S.P.Q. 2d 1481, 1486 (Fed. Cir. 1996), *cert denied*, 117 S.Ct. 1822 (1997).

The Board has recognized that if the commercial success is due to the merits of the claimed invention, the evidence of nonobviousness is to be accorded substantial weight. *Ex parte Remark*, 15 U.S.P.Q.2d 1498 (B.P.A.I. 1990).

The Federal Circuit has held that a *prima facie* case of nexus is made out when the patentee shows that there is commercial success, and the product or method that is commercially successful is the invention disclosed and claimed in the patent. *Demaco Corp. v. F. von Langsdorf Licensing Ltd.*, 851 F.2d 1387, 7 U.S.P.Q. 2d 1222, 1226 (Fed. Cir. 1988). A patentee is not required to prove as part of its *prima facie* case that the commercial success of the patented invention is not due to factors other than the patented invention. It is sufficient to show that the commercial success was of the patented invention itself. A requirement for proof of the negative of all imaginable contributing factors would be unfairly burdensome, and contrary to the ordinary rules of evidence. *Id.* at 1226-27.

A patent owner's lack of previous experience in a relevant market combined with high sales volume of the product provides an inference of a nexus between a commercial success and the patented invention and are probative evidence of nonobviousness. *Pro-Mold & Toll Co. v. Great Lake Plastics, Inc.*, 75 F.3d 1568, 37 U.S.P.Q. 2d 1626 (Fed. Cir. 1996). The Federal Circuit pointed out specifically in this case that the lack of market power in a field suggests that the novel features of the patented invention led to the commercial success.

Industry recognition is also probative in nonobviousness when related to the claimed invention. *In re Metz*, 173 F.3d 433 (Fed. Cir. 1998) (unpublished).

A combination of commercial success and copying by an infringer provides strong evidence of secondary consideration supporting a decision of nonobviousness. *Heidleberg Harris, Inc. v. Mitsubishi Heavy Industries, Ltd.*, Civ. App. No. 99-1100, 2000 U.S. App. LEXIS

23757, *30 (Fed. Cir. Sept. 18, 2000) (unpublished). If the evidence of copying includes reports indicating that the infringer followed the patentee's design and advertisement, these form an extremely persuasive indication of nonobviousness. *Id.* at *29-*30.

In this case, Applicants reurge the Declarations of Ms. Bonnie Pemberton and Mr. Charles Ruben, attached as Exhibits 4 and 5.

Ms. Pemberton testifies that from humble beginnings, the product incorporating the claimed invention rose from 0% market share to controlling almost 80% of the market share available. *See*, Declaration of Bonnie Pemberton at ¶8. The Declaration of Mr. Chris Ruben at ¶4 concurs. Ms. Pemberton further testifies that the details of market share, including the approximately size of the market and her percentage of sales. *See*, Declaration of Bonnie Pemberton at ¶¶7-8. She also testifies that her product incorporating the claimed invention was a replacement of the prior art which was greeted well by customers who voiced to her the advantages of the claimed features, including but not limited to, the features of the multiple layers, the bisected release layer and that the strength of the adhesive is sufficient to cause an unpleasant sticking sensation to pets. *See*, Declaration of Bonnie Pemberton at ¶¶ 9-11. The evidence shows that the claimed features responsible for the sales increase as opposed to other potential avenues such as advertising. Specifically, Ms. Pemberton testifies that the company doesn't spend a significant percentage of its budget on advertising and that the success of the product was because of the features. *See*, Declaration of Bonnie Pemberton at ¶14. Perhaps most telling, Applicants have sold over 1,500,000 packages of its product incorporating the invention since it was introduced in the market. *See*, Declaration of Bonnie Pemberton at ¶6.

Ms. Pemberton goes on to testify that she and her company were relatively inexperienced in the market before the success of the product and that the success of the product again was due to its features, and not her experience. *See*, Declaration of Bonnie Pemberton at ¶12.

The invention has been recognized in the industry with various awards. For example, in 1997 and 2003 the product incorporating the claimed invention won the “Editors Choice” award from Cat Fancy Magazine. Another example is the award for “Excellence” in 1999 from CATsumer Report. Still another example is the receipt of a formal “endorsement” from CATNIP! Newsletter in 1999. A further example is the “Seal of Approval” from the ASPCA in 2000. *See*, Declaration of Bonnie Pemberton at ¶13, Exhibits H, I and J.

The products incorporating the invention have been recommended in award-winning books, including:

- **Complete Kitten Care**, by **Amy D. Shojai**, a nationally known authority on pet care and behavior, a spokesperson for Purina®, and an award-winning author of more than a dozen nonfiction pet books.
- **Kittens for Dummies**, by **Dusty Rainbolt**, a nationally known authority on cat care and behavior, and an award-winning author and a regular contributor to the Whole Cat Journal and City + Country Pets.
- **The Cat Fanciers’ Association Complete Cat Book**, by **Mordecai Siegel**, a nationally known, highly-regarded and widely published authority on pet care.
- **Think Like A Cat**, by **Pam Johnson-Bennett**, a Certified Animal Behavior Consultant and clinical member of the International Association of Animal Behavior Consultants. She is the author of a number of award-winning and critically acclaimed books and one of the country’s most well-known and popular experts on cat behavior. *See*, Declaration of Bonnie Pemberton at ¶22.

Mr. Ruben testifies also that the claimed features of the invention have been mentioned to him favorably by customers large and small. Specifically, Mr. Ruben sets out that the features claimed in independent claim 1 among others are responsible for the success of the product. *See*, Declaration of Chris Ruben at ¶¶6-9.

The evidence also shows the nonobviousness of the invention by virtue of the close copying of the invention by at least two competitors. The first competitor is a larger, more well-established company than Applicants' company. *See*, Declaration of Bonnie Pemberton at ¶18, Exhibit D. Mr. Ruben also testifies that the product of the inventor incorporating the elements of the invention and at least one competitor's product move in the same channels of trade and are purchased by the same customers. *See*, Declaration of Chris Ruben at ¶5. For example, with respect to the first competitor, Applicants respectfully direct the attention of the Examiner to the virtual duplication of the product. The first competitor has copied the size and dimensions including the bisected release layer in its product. Moreover, in order to closely associate the competitive product with the product of Applicants' which incorporates the claimed invention, the first competitor has virtually copied the label and the instruction sheet, presumably in order to lead customers to believe that a competitive product incorporates the features of the claimed invention. *See*, Declaration of Bonnie Pemberton at ¶19, Exhibits A, D. The Examiner will also note that the competitive product does incorporate the claimed features of at least claim 1 including multiple layers and the bisected release layer. The instructions of the competitor specifically point out the structure and function of the features of the claimed invention. The first competitor has also used a nontoxic adhesive similar to that claimed by the invention. *See*, Declaration of Bonnie Pemberton at ¶¶18-19, Exhibit C, E, K.

As another example, the second competitor has also copied Applicants' product incorporating the claimed invention. *See*, Declaration of Bonnie Pemberton at ¶¶20-21, Exhibits F, G.

The second competitor not only copies the bisected release layer but the structure of the claimed invention. Moreover, the second competitor adopts similar product packaging and

instructions to those of the inventor to leverage the apparent similarity to the claimed invention.

See, Declaration of Bonnie Pemberton at ¶¶20-21, Exhibits F, G.

In summary, Applicants respectfully submit that the evidence of the secondary considerations provided is sufficient to overcome doubt as to the nonobviousness of the claimed invention.

Applicants also provide the Supplemental Declaration of Ms. Bonnie Pemberton, the inventor, as evidence of several secondary considerations that indicate that the invention is not obvious. In her Supplemental Declaration, Ms. Pemberton addresses comments made by the Office Action of September 25, 2006 discounting the evidence in her earlier Declaration. *See*, Exhibit 6.

The September 25, 2007 Office Action takes the position that the invention was merely replacement of the prior art double sided tape offered by the 3M Company and further that it was merely a repackaging and remarketing of a previous product. Ms. Pemberton testifies that this is not correct at ¶2 of her Supplemental Declaration. Ms. Pemberton goes on at ¶2 to testify that the 3M tape product did not have the features of the invention such as a base release sheet, a bisected top release sheet and was not provided in flat strips. She further testifies that the invention was not a repackaging of the prior art, but was rather substantially different and is a substantial improvement over it.

The September 25, 2007 Office Action further implies (without support) that an important factor in determining market success was whether the 3M tape product was sold in pet stores. Ms. Pemberton testifies in ¶3 of her Supplemental Declaration that in fact, the Examiner placed prior art in the file which describes two publications showing that double sided tape, such

as the 3M tape product were in fact publicized as a use for a cat deterrent.¹ But since there is no record of success of these uses of the 3M tape product, the evidence indicates that the success of Appellants' invention was not due to merely novel packaging, but rather due to the advantages of the claimed features of the invention.

The Examiner goes on to imply that the resulting rise in sales of Appellants' invention was due to its advertising as a cat deterrent and not because of the claimed features of the invention. Ms. Pemberton testifies on this point that in the years of selling the product, not a single customer has indicated that the product was purchased because of the advertising or packaging and not because of the claimed feature of the invention. Further, she goes on to point out that the declaration of Mr. Chris Ruben, sales agent for the product, indicates that numerous customers have told him that the products were purchased because of the claimed features of the invention.

Finally, the Office Action unnecessarily denigrates the ASPCA seal of approval by suggesting (without support) that the award was given to the Appellants prior to incorporating the features of the invention in exchange for payment. Ms. Pemberton testifies that the ASPCA award is given only after scrutiny for the function of the product and safety to pets and that it is not a quid pro quo for donations received. *See*, Supplemental Declaration of Bonnie Pemberton at ¶4.

Ms. Pemberton testifies that the ASPCA scrutinizes pet related products to ensure claimed functionality and the safety of pets. Ms. Pemberton further testifies that products submitted for the Seal of Approval are reviewed by a panel of ASPCA experts comprised of veterinarians, veterinary toxicologists, animal behaviorists, and animal science specialists

¹ Also see, *Basic Training for Your Cat*, <http://www.perfectpaws.com/train.html>; *Claws and All: Living With Your Cat, Your Furniture and Your Peace of Mind*, <http://www.nsus.org/claws.html> filed in support of the Office Action dated September 22, 1998.

nationally renowned in their scientific fields. *See*, Supplemental Declaration of Bonnie Pemberton at ¶4. Ms. Pemberton further testifies that the ASPCA award is only given after a review of the product for quality and safety (*See*, Supplemental Declaration of Bonnie Pemberton at ¶4), and that it is a bona fide award awarded to the product incorporating the features of the invention.

Applicants respectfully submit that the evidence of record shows, by a preponderance of evidence, that Applicants' invention is not obvious, especially in light of the numerous secondary considerations testified to by Ms. Pemberton and Mr. Ruben.

Related Application

Applicants desire to bring to the attention of the Office copending application no. 11/084,540. Applicants further direct the attention of the Office to claims 53, 56-58, 65-69, 73, 78-81, 91, 96-98, 105-106, and 108-109, which, on this date, stand rejected. Applicants further direct the attention of the Office to the art cited in the copending application as potentially related references, if not cited herein.

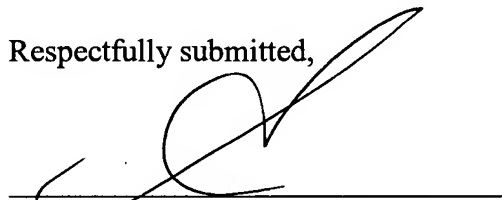
CONCLUSION

In view of the above, it is submitted that Claims 1-3 are in condition for allowance.

Applicants respectfully request reconsideration of the Application and earnestly solicit allowance. Should it facilitate allowance of the Application, the Examiner is invited to telephone the undersigned attorney.

Dated: November 26, 2007

Respectfully submitted,

A handwritten signature in black ink, appearing to read "George R. Schultz", is written over a horizontal line.

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